

10/712,286

Attorney Docket No. 14649

REMARKS**I. Claim Status.**

Claims 1-14 are pending in the application. Pursuant to 37 C.F.R. 1.121(c), no listing of claims is provided herewith because no claim changes, claim cancellations, or new claims are requested at this time.

II. Applicant's Invention.

Applicants' invention is directed to a porous book rack which has a "pencil case" attached to the bookrack. The invention combines a porous book rack with a pencil case which allows students to house larger items such as books and notebooks, yet still remain suitable for retaining smaller items, such as pencils, pens and rulers. Applicants' invention is a significant advantage to school districts because the combination of a pencil case and a porous book rack makes it difficult for a student to hide inappropriate objects (e.g., weapons, drugs, and other contraband) within the student's desk. Unfortunately, in modern times, there is a need for such an invention to increase the safety in our schools, and Applicants' invention satisfies this need.

III. The Rejection Under 35 U.S.C. § 103.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Barecki (U.S. No. 3,758,182) in view of Alexander (U.S. No. 2,185,907) for the reasons stated in numbered paragraph 2 of the Office Action.

Applicants respectfully traverse these rejection on the basis that the Office has not established a *prima facie* case of obviousness. Applicants respectfully request withdrawal of the rejection and allowance of Claims 1-14 based on the following remarks.

A. The Fact That The References Can Be Combined Or Modified Is Not Sufficient To Establish Prima Facie Obviousness.

As admitted by the Office, Barecki does not expressly disclose a pencil case attached to a bookrack. The Office looks to Alexander to remedy the deficiencies of Barecki, stating "Alexander ('907) discloses a tray (15) that *can be* used to hold pencils." (Office Action, page 2, emphasis added). The Office further states that "at the time of the invention it would have been

J:\Virco\14649\22 Response.doc

10/712,286

Attorney Docket No. 14649

obvious for a person of ordinary skill in the art to take [the] bookrack of Barecki ('182) and add the tray of Alexander ('907) to provide a desk and bookrack that has a tray that can hold articles within easy reach."

However, Alexander does not expressly disclose that the tray could be used as a pencil case. Further, Applicants note that the tray disclosed in Alexander is a curved tray that attaches to the corner of a table. (See, Alexander, Figure 1; col. 2, lines 30-47). To arrive at Applicants' claimed "pencil tray", one of skill in the art would have to modify the curved tray disclosed in Alexander, which wraps around the corner of a table, to a "pencil case" and then combine the modified tray with a book rack.

The Office has not provided prior art which suggests the desirability of modifying the tray disclosed in Barecki and combining it with a book rack to arrive at Applicants' invention, i.e., a "pencil case" attached to a book rack. Instead of properly citing to prior art which suggests the desirability of the modification and the combination, the Office asserts circular reasoning that it is obvious for a person of skill in the art to combine the bookrack of Barecki and add the tray of Alexander, "to provide a desk and bookrack that has a tray that can hold articles within easy reach." (Office Action, pages 2-3).

According to United States Patent Office practice and procedure, a mere statement that the individual aspects of the invention were known in the art, followed by circular reasoning to establish the reasoning for the combination is not sufficient to establish prima facie obviousness. There must be prior art which suggests the desirability of the combination, or a finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. See, MPEP 2143.01.

B. The Proposed Modification Renders The Tray Disclosed In Alexander Unsuitable For Its Intended Purpose.

The Office asserts that Alexander ('907) discloses a tray (15) that can be used to hold pencils. Contrary to the assertion of the Office, the curved tray disclosed in Alexander would not be suitable as a "pencil case", as claimed by Applicants. Accordingly, there is no motivation to

J:\Viroo\14649\22 Response.doc

10/712,286

Attorney Docket No. 14649

modify the tray disclosed in Alexander and combine it with a book rack, as disclosed in Barecki to arrive at Applicants invention, as the proposed modification would render the tray disclosed in Alexander unsuitable for its intended purpose.

Each of the independent claims, Claims 1, 5, 9, and 12 is limited to a "pencil case" attached to a book rack in varying language. The specification discloses that a "pencil case" is suitable for retaining items such as pens, pencils, rulers, and protractors and is inherently shaped to retain such items. (Specification, page 4, lines 20-23).

Alexander discloses a *curved* tray that attaches to the corner of a table (i.e., "an inner wall 18 which conforms to the curved corner portion of the bridge table and an outer curved wall 19 . . ." see, Alexander, Figure 1; col. 2, lines 30-47). The card table tray disclosed in Alexander is curved to conform to the corners of a bridge table and is recessed to hold items such as glasses and ash trays.

The curved tray taught by Alexander is unsuitable as a "pencil tray", which holds linear objects such as pencils, pens, and rulers. Accordingly, there is no motivation to combine Barecki with Alexander as modifying the tray disclosed in Alexander from a curved shape that extends around the corner of a table to a linear pencil holder, would render it unsatisfactory for its intended purpose as it would not fit around a table corner.

CONCLUSION

For the reasons stated herein, Applicants believe the claimed invention is patentable and request that the rejection under 35 U.S.C. § 13(a) be withdrawn. If any additional information should be required in considering this Response, or if there are any issues that can be resolved by telephone with the Applicants' representative, the Examiner is encouraged to contact the undersigned directly.

J:\Virco\14649\22 Response.doc


10/712,286

Attorney Docket No. 14649

No fee is believed due by this Response. However, if any fees are due, the Commissioner is authorized to charge any such fees to deposit account No. 19-2090.

Respectfully Submitted,
SHELDON & MAK PC

Date: September 30, 2005

By: 
Kristin C. Hübner, Ph.D.
Reg. No. 50,139

SHELDON & MAK PC
225 South Lake Avenue, 9th Floor
Pasadena, California 91101-3005

Telephone (626) 796-4000
Facsimile (626) 795-6321

J:\Virco\14649\22 Response.doc